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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,772	03/25/2004	Soo S. Ko	PH 7054 DIV2	7934
23914	7590	06/08/2006	EXAMINER HABTE, KAHSAY	
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			ART UNIT 1624	PAPER NUMBER

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,772

Applicant(s)

KO ET AL.

Examiner

Kahsay Habte

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/11/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-22,24,26-31,33,35-39,41,42 and 48-53 is/are pending in the application.
- 4a) Of the above claim(s) 48-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-22,24,26-31,33,35-39,41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-3, 5-22, 24, 26-31, 33, 35-42 and 48-53 are pending in this application.

Claims 48-53 are withdrawn from prosecution, but would be rejoined once the conditions of rejoinder are met.

Response to Amendment

2. Applicant's amendment filed 5/11/2006 in response to the previous Office Action (2/17/2006) is acknowledged. Rejections of claims 1-3, 5-22, 24, 26-31, 33, 35-42 and 48-53 under 35 U.S.C. § 112, second paragraph (item 6) and the obviousness rejection (items 3-4) have been maintained. This Office Action was not made FINAL because applicants indicated that they have filed a certificate of correction to delete unelected subject matter in US Pat. No. 6,759,411. Since the obviousness type double rejection is based on US Pat. No. 6,759,41, making this action Non-Final Rejection would give some time to the examiner and applicants to resolve the double-patenting issue.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3, 5-22, 24, 26-31, 33, 35-39, 41-42 and 48-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 36-37 and 41-45 of U.S. Patent No. 6,759,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap between the subject matter of the instant claims 1-3, 5-22, 24, 26-

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31, 33, 35-39 and 41-42 and the subject matter of claims 1-12, 36-37 and 41-45 of said U.S. Patent 6,759,411.

Response to arguments

Applicant's argument filed 05/11/2006 has been fully considered but it is not persuasive.

Applicants argue, "the deleted subject matter was subsequently printed in the granted patent (US Pat. No. 6,759,411). The claims as currently pending in the present application do not overlap with those of the allowed claims of the '411 patent. A certificate of correction for the '411 patent is being submitted concurrently with the response in order to delete the unelected subject matter from the '411 patent". Since the examiner is unable to check the certificate of correction for the '411 patent, the rejection is maintained until this issue is resolved.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-22, 24, 26-31, 33, 35-39 and 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 and claims dependent thereon are rejected because the proviso "when M is absent, J is

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selected from CH_2 , CHR^5 , CHR^{13} and CR^5R^{13} is not clear. Note that J is selected from CH_2 , CHR^5 , CHR^6 and CR^5R^6 and not CHR^{13} and CR^5R^{13} . Definitions of R^6 is not the same as the definition of variable R^{13} e.g. $R^6 = CN$ is missing from the definition of variable R^{13} .

Response to arguments

Applicant's argument filed 05/11/2006 has been fully considered but it is not persuasive.

Applicants argue, "the language 'when M is absent, J is selected from..' provides an alternative definition for J that is not mean to be the same as the earlier definition of J". The examiner disagrees with applicants. The variable J is selected from CH_2 , CHR^5 , CHR^6 and CR^5R^6 , but the proviso recite, "J is selected from CH_2 , CHR^5 , CHR^{13} and CR^5R^{13} ". In the proviso, applicants replaced variable R^6 by variable R^{13} . This can be done if the definition of variables R^6 and R^{13} are equivalent. Note that the definition of R^6 is not the same as the definition of variable R^{13} e.g. $R^6 = CN$ is missing from the definition of variable R^{13} . It is recommended that applicants change the definition of R^{13} in the proviso by R^6 .

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kahsay Habte', with a stylized, cursive script.

Kahsay Habte
Primary Examiner
Art Unit 1624

KH
June 2, 2006